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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,879	04/14/2004	William Vanbrooks Harrison	AB-238U3	5676

23845 7590 06/05/2006

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EXAMINER	
LE, HUYEN D	

ART UNIT	PAPER NUMBER
2615	

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/823,879	HARRISON ET AL.	
	Examiner	Art Unit	
	HUYEN D. LE	2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-10,12-14 and 21-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-10,12-14 and 21-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 8-10, 12-14 and 21-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 and 21-29 of copending Application No. 10/823,962. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming a Behind The Ear Implantable Cochlear Stimulation system, a behind the ear device, an in-the-ear microphone and a bendable, formable stalk that is attached to the in-the-ear microphone.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 8, 12-14, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huth (U.S. patent 3,098,127) in view of Toht (U.S. patent 2,930,856).

Regarding claims 8, 12 and 24, Huth teaches a behind-the-ear hearing aid system that comprises a behind-the-ear (BTE) device (7) including a circuitry (16), an in-the-ear (ITE) microphone (6, figures 1-3) including multiple terminals (20) and means for electrically connecting the terminal end of ITE microphone to the circuitry of the BTE device (7). Huth further teaches a bendable and formable stalk (8, col. 2, lines 59-60) as claimed (figure 3).

Huth does not specifically teach that the hearing aid system is an implantable Cochlear Stimulation system. However, providing a hearing system for an implantable Cochlear Stimulation system is known in the art.

Therefore, it would have been obvious to one skilled in the to provide the hearing aid system of Huth in the implatable Cochlear Stimulation system for greater application.

Huth further does not specifically teach a speech processor in the BTE device. However, Huth does teach a circuitry (16) for processing the electrical signals in the BTE device (7).

Therefore, it would have been obvious to one skilled in the art to provide any type of the circuitry in the BTE device (7) for processing the electrical signals such as a speech processor for better processing the electrical signals depending on the applications.

Huth does not specifically disclose a sound port for the microphone (6). However, the examiner takes the Office Notice that providing a sound port for the microphone is known in the art.

Therefore, it would have been obvious to one skilled in the art to provide a sound port in any location on the microphone (6) such as a sound port that points away from the longitudinal axis of the stalk (8) of Huth for better receiving the incoming signals.

Huth teaches the bendable and formable stalk (8) for positioning the ITE microphone within the concha of a user's ear (figure 3). Zilberman does not specifically teach that the stalk includes at least one stiffening member as claimed. However, providing a stiffening member for a connector element or a stalk for adjusting and positioning a transducer within the ear is known in the art.

Toht teaches means for connecting and positioning a transducer (2) in the ear that includes at least one stiffening member (figure 2, col. 1, lines 59-61).

Since Huth does estimate a flexible plastic material for the stalk; it therefore would have been obvious to one skilled in the art to provide a stiffening member in the stalk (8), as taught by Toht, for easily bending and better positioning the microphone within the ear.

Regarding claims 13-14 and 24, Huth teaches the stalk that is adapted to connect the ITE microphone to an earhook (21), wherein the earhook is removably attachable to the BTE device as claimed (col. 3, lines 23-56, figure 3).

Regarding claims 21-23, as broadly claimed, Huth shows the shrink tube (8) that is applied over a plurality of wound wires (18) as claimed (figures 2-3).

5. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huth (U.S. patent 3,098,127) in view of Toht (U.S. patent 2,930,856) and further in view of Flystad (U.S. patent 3,396,245) or Groppe (U.S. patent 5,086,464).

Regarding claims 9-10, Huth in view of Toht do not teach an earpiece of a communications handset that is held to the ear as claimed. However, providing a hearing or hearing aid device that is adapted to be utilized in connection with a communications device or a telephone handset is known in the art.

Flygstad or Groppe teaches a hearing aid for use with a telephone handset (figures 1 and 5 in Flygstad and figure 1 in Groppe).

Therefore, it would have been obvious to one skilled in the art to provide the system of Huth in view of Toht for use in connection with a telephone handset, as taught by Flygstad or Groppe for better operating a hearing aid with a communications device.

Response to Arguments

6. Applicant's arguments with respect to claims 8-10, 12-14 and 21-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUYEN D. LE whose telephone number is (571) 272-7502. The examiner can normally be reached on 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SINH TRAN can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HL
May 27, 2006

HUYEN LE
PRIMARY EXAMINER